

Attorney Docket No.: 094/004D

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## *Facsimile Transmittal Sheet*

**Date:** November 3, 2003

**To:** Ann Marie Falk, Ph.D.  
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Number of pages including cover: **6** (last page marked)

### **OFFICIAL FILING**

**Transmittal & Response to  
Restriction Requirement for**

**USSN 09/872,183**

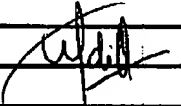
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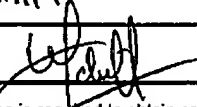
PTO/SB/21 (08-03)

Approved for use through 07/31/2006. OMB 0651-0031  
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<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)	Application Number	09/872,183	
	Filing Date	May 31, 2001	
	First Named Inventor	Melissa K. Carpenter	
	Art Unit	1632	
	Examiner Name	Anne Marie Falk	
Total Number of Pages in This Submission	4	Attorney Docket Number	094/004D

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request (in duplicate) <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) (in duplicate) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks 1. Response to Restriction Requirement (3 pages)		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm or Individual name	J. Michael Schliff, Registration No. 40,253	
Signature		
Date	November 3, 2003	

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I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.		
Typed or printed name	MICHAEL SCHLIFF	
Signature		Date November 3, 2003

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Name

Date

Nov 3/03

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: M.K. Carpenter

Art Unit: 1632

Filing Date: May 31, 2001

Examiner: Anne Marie Falk, Ph.D.

Serial No: 09/872,183

Docket: 094/004d

Title: MAKING NEURAL CELLS FOR HUMAN  
THERAPY OR DRUG SCREENING FROM  
HUMAN EMBRYONIC STEM CELLS

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents  
Alexandria VA 22313

Dear Sir,

This paper is responsive to the Restriction Requirement mailed on October 2, 2003 (Paper No. 7), for which a shortened statutory period for reply is set to expire on November 3, 2003, since November 2 is a Sunday. Accordingly, this paper is timely filed.

Please enter the following remarks.

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Election of Group for Examination

Claims 21-46 are pending in this application, and subject to a Restriction Requirement under 35 USC § 121 between claims in two groups.

Group I (claims 21-42 and 46) is hereby elected for examination on the merits.

Traverse of Restriction Requirement

Applicant respectfully traverses the restriction requirement.

Paper 7 indicates that Claims 43-45 (Group II) are drawn to a method of compound screening, distinct from the method for producing neural cell populations (Group I). This is incorrect, because Claim 43 is still a method for producing a neural cell population. After conducting the procedure recited in Claim 21, dependent Claim 43 *further* comprises a step of combining the cell population with a compound [for purposes of testing]. It is irrelevant whether methods to produce neural cell populations and methods for compound screening, are in general patentably distinct claim types. This is not the situation here, since all of the claims pending in this application require the user to conduct the procedure recited in Claim 21.

MPEP § 803 indicates that a restriction requirement can only be imposed when examination of all the claims would impose a serious burden. Indeed, no such burden exists. Upon determination that Claim 21 is free of the prior art, then Claims 43-45 will necessarily also be free of the prior art.

Reconsideration and withdrawal of the restriction requirement is respectfully requested.

Request for Rejoinder:

Claims 43-45 are method claims that depend from and incorporate the limitations of Claim 21. Should the Restriction Requirement be upheld, then applicant hereby requests that Claims 43-45 (and all other method claims depending from claims in the elected group) be rejoined upon determination that the claims in Group I are patentable. To facilitate and expedite prosecution, applicant urges that all pending claims be examined together from the outset.

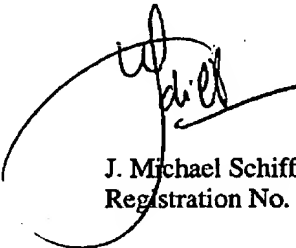
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Conclusion

Applicant respectfully requests that the application proceed to examination on the merits without further delay.

In the event the Examiner determines that an interview would facilitate prosecution of this application, she is invited to contact applicant's representative at the telephone number indicated below.

Respectfully submitted,



J. Michael Schiff  
Registration No. 40,253

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November 3, 2003



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